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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,787	02/06/2004	Sanjay Shah	GOLDSTAR 3.0-007	7914
7590	07/25/2005		EXAMINER	
EZRA SUTTON, P.A. PLAZA 9 BUILDING SUITE 201 900 ROUTE 9 NORTH WOODBRIDGE, NJ 07095			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	
DATE MAILED: 07/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/773,787	SHAH, SANJAY
Examiner	Art Unit	
David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 20 June 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_ .

## **DETAILED ACTION**

This office action is in response to Applicant's amendment filed 6/20/2005.

### *Status of Claims*

[1] Claims 1-20 are pending.

### *Specification*

[2] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 6/20/2005. Accordingly, the objection(s) to the specification have been withdrawn, and the abstract entered.

### *Claim Rejections - 35 USC § 103*

[3] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[4] Claims 1-6, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan, US-D460,018 in view of Wolf, US-D431,011, and in further view of Gurevich, US-6,442,971.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Chan teaches of a jewelry setting for receiving triangular-shaped gemstones or diamonds in the setting utilizing prongs and ultimately forming an oval arrangement.

However, Chan fails to disclose expressly of using other gemstone shapes or other arrangements for the gemstones different than that of an oval arrangement. Chan also does not specifically show of a base containing bar members.

Wolf teaches of a gemstone embodiment revolving around a different, more precise version of a triangular gemstone structure; while Gurevich teaches of a multi-stone round center setting for diamonds and gemstones including crossbars to help create specific seats for the individual gemstones within the jewelry setting.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the jewelry setting as taught by Chan, to incorporate an additional embodiment of triangular structure as suggested by Wolf, with additional base structures suggested by Gurevich, giving way to an embodiment of a jewelry setting by substituting the base members of Gurevich (36, 38 in Fig. 1) into the base of Chan and the gemstone of Wolf (Figure 1) for each of the four gemstones of Chan, and thus by such a substitution, the outside structure of the jewelry setting of Chan will be substantially rectangular-shaped and the individual triangular-shaped gemstones will be concretely positioned within specific seats providing another design choice for the user as described further below, as well as a more engaging environment for the gemstones to remain seated in.

Continuing, it would have been an obvious matter of design choice to modify the jewelry setting of Chan by substituting another embodiment of a triangular gemstone (Wolf) into the jewelry setting of Chan, since applicant has not disclosed that the substantially rectangular-shaped gemstone or diamond arrangement, that is, the rectangular shape, solves any stated problem or is of any particular purpose and it appears that different shapes would equally perform well as substitutes, as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Now as for Claim 1, Chan in view of Wolf and in further view of Gurevich teach of a multi-gemstone arrangement and a prong setting for receiving four substantially triangular-shaped gemstones or diamonds in the setting for forming a substantially rectangular-shaped gemstone or diamond arrangement; comprising:

- a) a prong setting including a prong assembly having four prong members (four members as shown in Fig. 1 of Chan);
- b) an upper rail assembly having four side rail members and four corner rail members; said four corner rail members being attached to said four prong members (the members found between prongs and around the gemstone as viewed in Figs. 3 and 4 of Chan, as well as 28 in Fig. 1 of Gurevich), respectively;
- c) an upper frame assembly having first and second crossbar members, said first crossbar member having first outer ends and said second crossbar member having second outer ends (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);

Art Unit: 3677

- d) said first and second crossbar members forming an X shaped configuration and each being connected at their respective first and second outer ends thereof to said corner rail members for forming four seating areas (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);
- e) each of said four seating areas for receiving therein one of said four triangular-shaped gemstones or diamonds within each of said four seating areas (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);
- f) said four-triangular shaped gemstones or diamonds each having three side walls and each having first and second retaining corners and a third apex corner (the gemstone as taught by Wolf in Figs. 1-4), respectively; each of said first and second retaining corners forming a corner retaining angle with at least two of said side walls (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);
- g) each of said four prong members each having a retaining insert slot formed therein for receiving and engaging at least a portion of said first and second retaining corners of two adjacent gemstones or diamonds to keep said four gemstones or diamonds seated within each of said four seating areas of said prong setting (the notches in the prong members as viewed in Fig. 1 of Chan).

As for Claim 2, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein each of said four prong members includes an upper prong end, a lower prong end, an exterior wall surface and an interior wall surface having a center section area (the prongs as shown by Chan in Figs. 1-4).

As for Claim 3, Chan teaches of multi-gemstone arrangement, Re: Claim 2, wherein each of said four corner nail members is attached to said interior wall surface at said center section area of each of said four prong members, respectively (Figs. 3 and 4 of Chan).

As for Claim 4, Chan teaches of multi-gemstone arrangement, Re: Claim 2, wherein each of said retaining insert slots is positioned at said upper prong end on said interior wall surface of each of said four prong members (the slots at the upper section of the prong members holding segments of two gemstones as shown in Figs. 1 and 2).

As for Claim 5, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein said prong setting further includes a lower frame assembly having four lower frame side rail members for providing additional structural strength to said prong setting (lower side rail members as shown in Figs. 1, 3, and 4 of Chan).

As for Claim 6, Chan teaches of multi-gemstone arrangement, Re: Claim 2, wherein each of said lower frame side rail members is attached to said lower prong end of each of said four prong members, respectively (lower side rail members attached to the lower prong members as shown in Figs. 1, 3, and 4 of Chan).

As for Claim 11, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein one of said three side walls of said triangular-shaped gemstone or diamond is an outer wall being adjacent and parallel with one of said four side rail members (Chan in view of Gurevich and

Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, resulting in the one of the three side walls of the triangular gemstone being an outer wall of the overall structure).

As for Claim 16, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein said corner retaining members of two adjacent triangular-shaped gemstones or diamonds have said corner retaining angles gamma and delta being in alignment with each other to cooperate in forming a straight edged corner member being received within each of said retaining insert slots of said four prong members (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, allowing the corners of the triangular gemstone of Wolf to be engaged within the slots of the prongs taught by Chan).

[5] Claims 7-10, 12-15, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan, US-D460,018 in view of Wolf, US-D431,011, and in further view of design choice.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Multiple inventors disclose varying sizes and shapes of gemstones, as it is readily known within the art that such changes are necessary to accompany a specific design choice, and finalizing exact dimensions of a structure of an assembly for overall appearance purposes. It would have been obvious to one having ordinary skill in the art at the time the invention as made

Art Unit: 3677

to create multi-stone embodiments with varying angles and corners as well as an environment catering to different size settings to account for different carat sizes as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

[6] As for Claims 18 and 20, the examiner takes notice that creating parts of a jewelry setting or arrangements from metals such as gold, silver, etc, is readily an old and well-known design consideration to those familiar in the art. Also, the medium by which such jewelry arrangements are submitted to, such as a ring, necklace, pin, etc, is also a old and well-known design consideration to those familiar to the art, and are thus, obvious and not novel.

#### *Response to Arguments*

[7] Applicant's arguments filed 6/20/2005 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. To begin, in response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443, F.2d 1392; 170 USPQ 209 (CCPA 1971).

Continuing on to the applicants specific rebuttals beginning with the statement that there is no teaching in the Chan design patent that its multi-stone jewelry setting has first and second crossbar members that form an X shaped configuration for its prong setting. This is true, Chan's

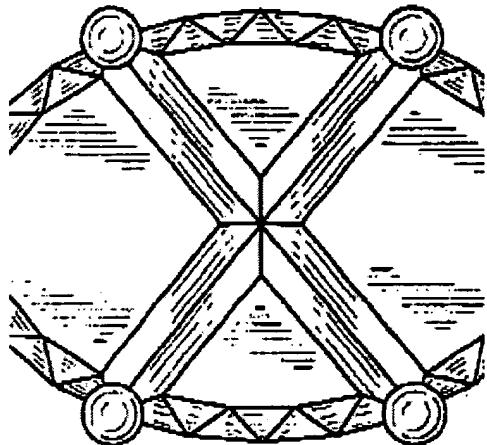
Art Unit: 3677

design patent does indeed not teach of first and second crossbar members. Chan, as prior art, however, was not used for the purpose of showing such a feature. Gurevich is the fundamental prior art with respect to the first and second crossbar members as his patent teaches of such the ability to use crossbar members for supporting up to six gemstones. The purpose of the crossbars of Gurevich was to show that one could easily consult the reference of Gurevich and substitute such a crossbar feature into any given jewelry setting. And since in Gurevich, the crossbar members are directly representative to the position and number of prong members, one can easily surmise that if one were to input crossbar members in the jewelry setting of Chan, they would form a X configuration due to the position of the prong members of Chan. Continuing on to the latter argument surrounding Gurevich and how applicant believes that he does not show of an X shaped configuration for its prong setting. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). With such reasoning, it is easy to interpret the structure of Gurevich shaped as an X. 50 in the figures just happens to be the center of the X crossbar. It is without a doubt a matter of art recognized equivalence, as incorporating such a feature would be readily apparent to one skilled in the art. To further prove the equivalence of such a feature, examiner would also like to point out Benderly, US-D334,154; wherein in Fig. 10, another example of such a X-shaped configuration for crossbar members is shown.

The same line of thinking can be applied to the next argument, where it is once again important to point out that the shape of a gemstone used in a jewelry setting is merely a matter of design choice and going from the gemstone shape of Chan to that of Wolf would be completely familiar to one skilled in the art as it is once again purely a matter of art recognized equivalence.

In substituting such a shape of a gemstone into that instantly provided by Chan, one can easily see that the limitations set forth in claim 1(f) are satisfied.

Continuing, true, there is no teaching in Gurevich's prong setting that each of the four prongs have a retaining insert slot for engaging a portion of the first and second retaining corners or two adjacent gemstones. Once again, Gurevich was primarily used to show the pertinence of the crossbar features not for the prong member features; the prong members from Chan are the ones that have anticipate the instant invention; as one can see in the figures of Chan, preferably Figures 1 and 2, it is readily apparent, especially to one skilled in the art, that to achieve the prong-gemstone setting relationship without cutting the edges of the gemstone, the prong members much have a notch occupied wherein the edge of two gemstones fit (see below).



In conclusion, each of the aforementioned features is not a truly novel feature by itself, as shown by the prior art. Though one piece of prior art does not disclose each and every feature by itself, when jewelry is concerned, much structure is purely a matter of design choice and incorporating different features into different settings is merely a matter of user preference and in general such variety is considered a matter of art recognized equivalence.

Art Unit: 3677

***Conclusion***

**[8] THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**[9]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. **Until July 14<sup>th</sup>, the fax phone number for the organization where this application or proceeding is assigned is 703-872-9306; starting July 15<sup>th</sup>, however, the new fax phone number will be (571) 273-8300, please make note.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Assistant Examiner  
Art Unit 3677

DCR

  
ROBERT J. SANDY  
PRIMARY EXAMINER